

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No.	:	09/774,968	Confirmation No.	6029
Applicant	:	Zebian, Marwan		
Filed	:	01/31/2001		
TC/A.U.	:	2154		
Examiner	:	Patel, Ashokkumar B		
Docket No.	:	U00-P02026US		
Customer No.	:	33356		

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Reply Brief Under 37 C.F.R. § 41.41

Dear Sir:

The following Reply Brief is submitted in response to the Examiner's Answer mailed June 1, 2006.

A. Rejection of Claims 1-11 as Upatentable over West

To anticipate a claim under 35 U.S.C. § 102, the reference must teach each and every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 USPQ2d 1051, 1053 (Fed. Cir. 1987).

West Does Not Teach Setting an Order for Selecting NANs in a User NAN List Based Upon Connection Information Wherein the Order is Set Outside the User's Control

Claim 1 recites, among other limitations, "setting an order for selecting the NANs in the user NAN list based upon the connection information wherein the order is set outside of the user's control." The preamble of claim 1 recites, "the NANs for use by a user's client device in connecting to a data network under control of a server system." In the Appeal Brief, the Appellant asserted that West did not teach the claimed features at 2:58-63. In the Examiner's Answer, the Examiner did not contest this logic and therefore it must be concluded that the Examiner agreed with the Appellant.

Because the cited portion of West does not teach "setting an order for selecting the NANs in the user NAN list based upon the connection information wherein the order is set outside of the user's control", the Examiner has not met the required showing that West teaches what is recited in claim 1. As such, the rejection should be reversed.

By virtue of their dependency from claim 1, claims 2-11 are patentable over West. As such, the anticipation rejection of the claims 2-11 should be reversed.

B. Rejection of Claims 12-25 and 30-35 as Unpatentable over West in view of Dieterman

"To establish a *prima facie* case of obviousness, [. . .] the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20

USPQ2d 1438 (Fed. Cir. 1991).

West in view of Dieterman Does Not Teach or Suggest Transmitting an Identification of the NANs in the User NAN List from the Client Device to the Online Service Provider Server System

Claim 12 recites, among other limitations, “transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system.” In the Appeal Brief, the Appellant asserted that West did not teach the claimed features at Figs. 2a – 2c. In the Examiner’s Answer, the Examiner did not contest this logic and therefore it must be concluded that the Examiner agreed with the Appellant.

Because neither West nor Dieterman teach or suggest “transmitting an identification of the NANs in the user NAN list from the client device to the online service provider server system”, the rejection should be reversed. By virtue of their dependency from claims 12, claims 13-25 are patentable over West in view of Dieterman. As such, the obviousness rejection of the claims 13-25 should be reversed.

Respectfully submitted,

Date: July 18, 2006



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